

ARGUMENTS / REMARKS

Claims 1-3, 5 and 7-16 are pending in the application. Claims 7, 10, 13 and 16 have been previously withdrawn. Claims 4 and 6 have been previously cancelled.

As set forth in the above listing of claims, each of independent claims 1 and 2 has been amended. Dependent claims 3 and 5 have been previously amended.

In the Final Office Action dated March 24, 2005, the Examiner rejected each of claims 1-3, 5, 8, 9, 11, 12, 14 and 15 as being unpatentable under 35 U.S.C. §102(b) or 35 U.S.C. §103. A discussion of the various cited references is provided separately below.

A. Rejection of Claims 1, 3 and 11 under Boulet.

Claims 1, 3 and 11 have been rejected under 35 U.S.C. §102(a) as being anticipated by French Patent No. 1.013.219 issued to Boulet. Claim 1 is an independent claim directed to a pen holder. Claims 3 and 11 each depend from claim 1.

In support of claim 1, Applicant would first show that claim 1 has been amended to clarify that the body receives separate writing instruments in outwardly facing recesses. The recesses are outwardly facing on opposing ends of the body for easy access. In addition, the diameter of the second recess is at least 50 percent larger than the diameter of the first recess.

In contrast, Boulet does not show a single device having these combined features. Figures 1-3 of Boulet demonstrate a device in one embodiment having two recesses. However, the openings for these recesses are central to the body of the device, and are not outwardly facing. In addition, the Examiner has stated that the two recesses are capable of receiving "holding writing instruments of different dimensions because the recesses of the flexible body are capable of being expanded to accommodate different size of pens." The Examiner has referenced FIG. 2, stating that "Figure 2 shows an example that crayon 7 of slightly larger dimension than that of pen 4 held in the recesses 1 and 2."

The undersigned counsel has measured the diameters of crayon 7 and pen 4 shown in FIG. 2. Counsel remains unable to discern any dimensional difference in the size of either the recesses or the writing tools themselves. Each writing tool 7, 4 has a diameter (as measured on a standard 8 ½" x 11" printout) of approximately 0.5 cm.

Even if the drawings of Boulet did show slightly different radial dimensions for the instruments or the sleeves, Applicant would again note that it has been held that relative dimensions in cited drawings are not to be deemed as prior art unless delineated in the specification of the cited reference. *See, e.g., Nystrom v. Trex Co.*, 71 USPQ2d 1241, 1250 (Fed. Cir. 2004) (patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is "silent on the issue.") (citing *Hockerson-Halberstadt, Inc. v. Avia Group International, Inc.*, 55 USPQ2d 1487 (Fed. Cir. 2000)).

Applicant has now obtained an English translation of the French patent cited by the Examiner to determine whether specific dimensions are discussed. A copy of the translation (and certification page) is attached. The specification of the Boulet patent confirms that the device has one or more sleeves for receiving different writing instruments. The enumerated instruments include pencils, mechanical pencils, fountain pens, ball point pens, crayons and erasers. The specification states that these instruments may be of "different lengths" or of "various widths". However, no specific relative diameters are stated, and the only relative diameters shown in the drawings are substantially the same (if not identical).

In an alternate embodiment, Figure 6 of Boulet shows a device having two recesses, and having outwardly facing openings in opposing ends. However, these recesses appear to be of identical dimensions. While Boulet does state that the device may be "elastic," it does not state that a user could removably insert a ball point pen in one recess and a much larger board-marker or other significantly larger instrument in the other.

Applicant has amended claim 1 to provide that the diameter of the second recess is at least 50 percent larger than the diameter of the first recess. This is not new matter, as FIG. 1 of the pending application shows that the first recess 12 has a diameter (in perspective view) of approximately 1 cm, while the second recess 13 is drawn to have a diameter (in perspective view) of approximately 1.8 cm. While claim 1 is not limited to a pen holder having recesses of any particular size, the relative dimensions of the two recesses is important. Boulet does not teach, show or suggest sleeves wherein a second sleeve has a diameter that is at least 50 percent larger than the diameter of a first sleeve.

Applicant respectfully submits that claim 1 is allowable over Boulet. Because claim 1 is allowable over Boulet, Applicant submits that dependent claims 3 and 11 are likewise allowable.

B. Rejection of Claims 2, 5 and 12 under Boulet.

Claims 2, 5 and 12 have also been rejected under 35 U.S.C. §102(a) as being anticipated by French Patent No. 1.013.219 issued to Boulet. Claim 2 is an independent claim directed to a pen holder. Claims 5 and 12 each depend from claim 2.

In support of claim 2, Applicant would first show that claim 2 has been amended to clarify that the body receives separate writing instruments in a plurality of outwardly facing recesses. The recesses are outwardly facing on opposing ends of the body for easy access. In addition, the diameter of the second recess is at least 50 percent larger than the diameter of the first recess.

In contrast, Boulet does not show a single device having these combined features. Figures 1-3 of Boulet demonstrate a device in one embodiment having two recesses. However, the openings for these recesses are central to the body of the device, and are not outwardly facing. In addition, the Examiner has stated that the two recesses are capable of holding "writing instruments of different dimensions because the recesses of the flexible body are capable of being expanded to accommodate different size of pens." The Examiner has referenced FIG. 2, stating that "Figure 2 shows an example that crayon 7 of slightly larger dimension than that of pen 4 held in the recesses 1 and 2."

As noted, the undersigned counsel has measured the diameters of crayon 7 and pen 4 shown in FIG. 2. Counsel remains unable to discern any dimensional difference in the size of either the recesses or the writing tools themselves. Nevertheless, Applicant has amended claim 2 to provide that the diameter of the second recess is at least 50 percent larger than the diameter of the first recess. This is not new matter, as FIG. 6 of the pending application shows that a first recess 12 has a diameter (in plan view) of approximately 1.25 cm, while a second recess 13 is drawn to have a diameter (in plan view) of approximately 2.0 cm. While claim 2 is not limited to a pen holder of any particular size, the relative dimensions of the various recesses is important.

Applicant respectfully submits that claim 2 is also allowable over Boulet. Because claim 2 is allowable over Boulet, Applicant submits that dependent claims 5 and 12 are likewise allowable.

C. Rejection of Claims 1 and 3 under Adams.

Claims 1 and 3 have been rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,238,459 issued to Adams. Claim 1 is an independent claim directed to a pen holder; claim 3 depends from claim 1.

Adams provides a clamp for holding decorative lights "and other objects." The specification does mention "pens, pencils and markers" as the other objects. However, the clamp of Adams does not have outwardly facing openings in opposing ends of the body as claimed in amended claim 1; rather, the openings are inwardly facing and are central to the body. Having openings facing outwardly of the body makes the device of the present invention far more functional in that a pen or a marker can be quickly inserted or released by lateral force.

D. Rejection of Claims 2 and 5 under Adams.

Claims 2 and 5 have also been rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,238,459 issued to Adams. Claim 2 is an independent claim directed to a pen holder; claim 5 depends from claim 2.

As noted, Adams provides a clamp for holding decorative lights "and other objects." The specification again mention "pens, pencils and markers" as the "other objects." However, the clamp of Adams does not have outwardly facing openings in opposing ends of the body as claimed in amended claim 2; rather, the openings are central to the body. Having openings facing outwardly of the body again makes the device of the present invention far more functional so that a pen or a marker can be quickly inserted or released by lateral force.

E. Rejection of Claims 8 and 9 over Boulet in view of Chau.

Claims 8 and 9 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Design Patent No. 266,335 issued to Chau. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Boulet, that dependent claims 8 and 9 are likewise allowable.

F. Rejection of Claims 8 and 9 over Adams in view of Chau.

Claims 8 and 9 have also been rejected under 35 U.S.C. §103(a). The Examiner has cited Adams in view of U.S. Design Patent No. 266,335 issued to Chau. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Adams, dependent claims 8 and 9 are likewise allowable.

G. Rejection of Claims 14 and 15 over Boulet in view of Mullins.

Claims 14 and 15 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Patent No. 6,276,854 issued to Mullins. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Boulet, dependent claims 14 and 15 are likewise allowable.

H. Rejection of Claims 14 and 15 over Adams in view of Mullins.

Claims 14 and 15 have been rejected under 35 U.S.C. §103(a). The Examiner has cited Boulet in view of U.S. Patent No. 6,276,854 issued to Mullins. These are dependent claims which depend from independent claims 1 and 2, respectively.

Applicant respectfully submits that because claims 1 and 2 are allowable as discussed above over Adams, dependent claims 14 and 15 are likewise allowable.

I. Cancellation of Withdrawn Claims.

Applicant is agreeable to canceling withdrawn claims 7, 10, 13 and 16 in order to obtain allowance of the remaining pending claims.

CONCLUSION

Having addressed all issues set out in the Final Office Action, Applicant respectfully submits that the claims are in condition for allowance and respectfully requests that the claims be allowed. Applicant states that arguments made in connection with one set of claims should not be construed as, and are not intended to be, limitations for other sets of claims herein.

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicant's disclosure than the primary references cited in the Office Action. Therefore, Applicant believes that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

Respectfully submitted,



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